

### **REMARKS**

Claims 1, 15-18, 27 and 37 are pending in this application.

The Office Action dated September 16, 2008, has been received and carefully reviewed. In that Office Action it was indicated that claims 15-18 were allowed.

### **APPARENT FAILURE TO FOLLOW THE MPEP**

First, it is noted that the amendment to claim 37 of September 13, 2007, was filed well within the two month period provided by the Decision on Appeal of the Board that was mailed on August 3, 2007. Under MPEP §707.02, the present application that has been pending for more than five years should have been "carefully studied by the supervisory patent examiner" (SPE) and every effort should have been made "to terminate its prosecution" which is specifically noted to include having the application "considered 'special' by the examiner". The more than one year delay from the filing of the amendment of September 13, 2007, until the mailing of the outstanding Action on September 16, 2008, does not appear to reflect this required MPEP §707.02 treatment of this application that has been pending for over eight (8) years in any "special" manner.

Second, it is noted that the outstanding Action mailed more than one year after applicant's above noted amendment date further appears to violate the reference citation dictates of MPEP §1214.07. In this respect, MPEP §1214.07 states that it is only when "the examiner has specific knowledge of the existence of a particular reference or references which indicate non-patentability of any of the appealed claims as to which the examiner was reversed," that the examiner can submit the matter to the Technology Center (TC) Director for authorization to reopen prosecution based upon such newly cited prior art. MPEP § 1214.07 emphasizes that "[t]he examiner should never regard such a reversal as a challenge to make a new search to uncover other and better references."

Also, while the Board made a new ground of rejection as to claim 37 being asserted to not being drawn to 35 U.S.C. §101 subject matter, this 35 U.S.C. §101 rejection of just claim 37

does not serve to reopen prosecution in general or require the performance of any new search of the prior art as to Claim 37 subject matter. See MPEP §1214.01.

The above-noted MPEP §1214.07 and MPEP §1214.01 statements of Patent Office policy notwithstanding, a new search appears to have been made as to the citation of five new references (Koz, Horne, Dorricott, Weiss, and Nakagawa) as some how being of “interest” but not sufficiently “of interest” in terms of somehow rendering the subject matter of any pending claim unpatentable. Even if these five new references were not the result of a prohibited new search having been performed, the citation thereof still clearly goes against the mandate of MPEP §1214.07 that only “references which indicate non-patentability of any of the appealed claims” that are within the examiner’s knowledge can be cited.

#### **MPEP §707.02 and MPEP §1214.07 PROVISIONS MUST BE FOLLOWED**

With regard to each of the above noted failures of the PTO to follow MPEP §707.02 and MPEP §1214.07, *In re Kaghan*, 387 F.2d 398, 401, 156 USPQ 130, 132 (CCPA 1967) notes that when “the express provisions of MPEP set forth an established Patent Office policy” then “applicants for patents are entitled to rely” on such “established Patent Office policy” being followed.

Thus, the prosecution of this application is expected to proceed as being “special” with the **personal attention** of the SPE as required by MPEP §707.02 to insure that every effort is made “to terminate its prosecution” and to insure that the examiner will now promptly proceed, without performing any further MPEP §1214.07 prohibited new searches, in a manner permitted under MPEP §1214.07. That is, if any reference is cited, the SPE should insure it actually demonstrates unpatentability of one of claims 1, 27, and 37, unlike the relied upon reference treated below.

#### **THE REJECTION OF CLAIMS 1, 27, AND 37**

The outstanding Action of September 16, 2008, also included a new ground of rejection as to claims 1, 27, and 37 under 35 U.S.C. §102(e) as being anticipated by Sugano et al. (U.S.

Patent No. 6,473,459, hereinafter "Sugano") in item 3 on page 2 thereof. This rejection is traversed.

As noted in MPEP §706.02(b), any rejection that is based on 35 U.S.C. §102(e), like the present rejection of claims 1, 27, and 37, can be overcome by perfecting a claim to priority under 35 U.S.C. §119 and 37 C.F.R. §1.55(a)(4) of an earlier date than that of the relied upon reference. As further noted in MPEP §706.02(b), this "perfecting" is done by filing an English Translation of the foreign language document (here JP 10-338658, filed November 30, 1998) together with a statement that the translation of the certified copy of the foreign language document is "accurate."

As an English Translation of the priority application JP 10-338658, filed November 30, 1998, is being filed with this Request for Reconsideration along with the required statement by the translator that the translation of the certified copy the foreign language document is accurate, 35 U.S.C. §119, 37 C.F.R. §1.55(a)(4), and MPEP §706.02(b) require that this application be considered to have a perfected foreign priority date of November 30, 1998. Accordingly, the rejection of claims 1, 27, and 37 under 35 U.S.C. §102(e) as being anticipated by Sugano has now been overcome. In this last regard, the 35 U.S.C. §102(e) date of Sugano is only February 23, 1999, a date after this perfected foreign priority date of November 30, 1998, and Sugano is clearly not a "prior art" reference under 35 U.S.C. §102(e).

Consequently, withdrawal of the new rejection of claims 1, 27, and 37 as under 35 U.S.C. §102(e) as being anticipated by Sugano is respectfully requested.

**CONCLUSION**

In light of the allowance of claims 15-18 and the withdrawal of the rejection of claims 1, 27, and 37, formal allowance of the present application with claims 1, 15-18, 27, and 37 is respectfully requested.

Should there be any outstanding matters that need to be resolved in the present Application, the Examiner is respectfully requested to contact Raymond F. Cardillo, Reg. No. 40,440 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite the above-noted protracted prosecution that has included the above-noted appeal to the Board of Patent Appeals and Interferences that resulted in the reversal of the previous prior art rejection applied as to claims 1, 27, and 37.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: December 12, 2008

Respectfully submitted,

By   
Charles Gorenstein

Registration No.: 29,271 #52327  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Road  
Suite 100 East  
P.O. Box 747  
Falls Church, Virginia 22040-0747  
(703) 205-8000  
Attorney for Applicant

Attachments: Verified Translation of Priority Document JP-10-338658